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09/545,316 04/07/00 ROSS

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EXAMINER

HLIYNH, T
ART UNIT PAPER NUMBER

2176
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07/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/545,316

Applicant(s)

ROSS ET AL.

Examiner

Thu v Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-24 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

1. This action is responsive to communications: application filed on 04/07/2000; IDS filed in page number 4.
2. Claims 1-24 are pending in the case. Claims 1, 9, and 22 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claims 1, 5, 6, 7, 8, 21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maddison et al., "Peer review", copyright 1998, pages 1-3 in view of Pope et al., "Using the web for peer review and publication of scientific journals", September 1998, pages 1-10, and Mathews et al., "Electronic Management of the Peer Review Process", May 6-10, 1996, pages 1-21.**

Regarding independent claim 1, Madison discloses the steps of:

- qualified reviewers are assigned to review the article (page 2, lines 20-23, Madison discloses that the step of assigning reviewers to review the article based on the reviewers' expertise and the subject of the article).

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- the reviewers complete an evaluation form for the article (page 2, lines 27-29, Madison discloses that the reviewer is able to enter comments into a evaluation form on the web page).
- the author enters responses to the reviewers evaluation form (page 2, lines 36-39, Madison disclose that the author responses to the reviewers). However, Madison does not explicitly discloses that how the author responses to the reviewers evaluation form. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have appreciated that the author responses to the reviewers evaluation form “directly into the evaluation form” to facilitate the peer review process, since the reviewers and authors are able to use the evaluation form to communicate to each other.
- the editors consider each reviewer’s evaluation form and the author’s responses (page 2, line 34 – page 3, line1. Madison discloses that additional reviewers may be engaged based on *contradictory evaluation by reviewers* and *disagreement between reviewers and author*, which suggests the step of the editors also consider reviewer’s evaluation form and the reviewers’ evaluation before assigning additional reviewers).
- the reviewers submit the evaluation form to the journal (page 2, lines 27-33, Madison discloses that the reviewers is able to enter comments into a evaluation form on the web page).
- the editor examines the evaluation form and makes a publication decision (page 2, line 27 – page 3, line 5, Madison discloses that the editor examines the evaluation form to decide the result for the article).

However, Madison does not disclose the steps of: the author submits an article to the journal via network; the editors inform the author and the reviewers of the publication decision.

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Pope teaches the steps of:

- the author submits an article to the journal via network (page 2, lines 1-4 from the bottom, Pope discloses the step of using the network to submit an article to a journal).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Madison and Pope to make Madison's peer review process on-line, as Madison disclosed "Reviews are usually conducted on-line" (page 2, line 27), as Pope disclosed "made it possible to conduct the entire peer-review process on-line" (page 1, lines 4-5).

However, Madison and Pope do not disclose the step of: the editors inform the author and the reviewers of the publication decision.

Mathews discloses the step of:

- the editors inform the author and the reviewers of the publication decision (page 7, lines 25-36, Mathew discloses that the publication decision is inform to the author via email, and the reviewers can examine the report of the decision).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Madison, Pope, and Mathews to provide the announcement of the result for the authors as well as the reviewers, since in the business practice, both the reviewers and the authors are people who expect the result.

Regarding dependent claim 5, which is dependent on claim 1, refer to the rationale relied to reject claim 1, in which "each reviewer submits the evaluation form by connecting to the Web site and entering comments into the evaluation form" is addressed.

Regarding dependent claim 6, which is dependent on claim 1, Madison, Pope, and Mathews

teach the limitation of claim 1 as explained above. Pope also discloses that the articles submitted by the author are automatically reformatted into a standard format by the journal (page 3, line 1-27, Pope discloses that the software “mounts an HTML version of the complete article”). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Madison, Mathews and Pope to make Madison’s peer review process on-line applicable to any type of journal publication, since “reformat into a standard format” would have helped different kind of journals converts the submitted article to satisfy the format requirements.

Regarding dependent claim 7, which is dependent on claim 1, Madison, Pope, and Mathews teach the limitation of claim 1 as explained above. Pope also discloses that the authors need password to access the Web site (page 7, lines 4-6). Mathew also discloses that the reviewers need a username and password to access the system to update review (page13, lines 1-6, from the bottom). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Madison, Pope, and Mathews to protect the integrity of work, since using username and password ensure that only authorized people such as authors, reviewers, editors can work on the article.

Regarding dependent claim 8, which is dependent on claim 1, refer to the rationale relied to reject claim 1, in which “the author is informed of the publication decision by email” is addressed.

Regarding independent claim 21, Madison teaches the steps of:

- the reviewers reviewing the article and providing an evaluation form to the author and editors through the Web site (Madison, page 2, lines 20-39).

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- the author responding to the reviewers comments (page 2, lines 36-39, Madison disclose that the author responses to the reviewers). However, Madison does not explicitly disclose that how the author responses to the reviewers evaluation form. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have appreciated that the author responses to the reviewers evaluation form “directly within each evaluation form” to facilitate the peer review process, since the reviewers and authors are able to use the evaluation form to communicate to each other.
- the editors examining each evaluation form, making a publication decision regarding the article (Madison, page 2, line 34 – page 3, line 5).

However, Madison does not disclose the steps of: an author submits an article to the Web site; and notifying the author and reviewers of the publication decision.

Pope discloses the step of:

- an author submitting an article to the Web site (page 2, lines 1-4 from the bottom, Pope discloses the step of using the network to submit an article to a journal).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Madison and Pope to make Madison’s peer review is able to process on-line, as Madison disclosed “Reviews are usually conducted on-line” (page 2, line 27), as Pope disclosed “made it possible to conduct the entire peer-review process on-line” (page 1, lines 4-5).

However, Madison does not disclose the step of: notifying the author and reviewers of the publication decision.

Mathews discloses the step of:

- notifying the author and reviewers of the publication decision (page 7, lines 25-36, Mathew discloses that the publication decision is inform to the author via email, and the reviewers can examine the report of the decision).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Madison, Pope, and Mathews to provide the announcement of the result for the authors as well as the reviewers, since in the business practice, both the reviewers and the authors are people who expect the result.

Regarding dependent claim 23, which is dependent on claim 21, Madison, Pope, and Mathews teach the limitation of claim 21 as explained above. Madison discloses that a group of authors collaborate to co-author an article and submit the co-authored article (page 1, line 10- 17). Madison's peer review process does not explicitly disclose that a group of authors collaborate to co-author an article and submit the co-authored article "via Web site". Pope teaches the method of "using web for peer review and publication of scientific journals" (Pope's title) to "made it possible to conduct the entire peer-review process on-line" (Pope, page1, lines 4-5). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Madison, Mathews, and Pope to facilitate the peer review process when the big project or journal is working on, which need many author's knowledge, since the entire Madison's peer review process on-line, the co-authors are more convenient to contact each other as well as submit a part of article or respond to the reviewers.

Regarding dependent claim 24, which is dependent on claim 23, Madison teaches the

limitation of claim 23 as explained above. Madison also discloses that authors work on the multi-chapter book (page 1, line 14-17), and further, Madison discloses that authors respond to the evaluation form (page 2, line 34-39), which implies that each co-author responds to each evaluation form.

5. Claims 9-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pope et al., "Using the web for peer review and publication of scientific journals", September 1998, page 1-10, in view of Maddison et al., "Peer review", copyright 1998, pages 1-3, and Mathews et al., "Electronic Management of the Peer Review Process", May 6-10, 1996, pages 1-21.

Regarding independent claim 9, Pope teaches the steps of:

- an author connects to the Web site and submits an article to the Web site (Pope, page 2, lines 1-4 from the bottom).
- the Web site searches a database and generates a ranked list of qualified potential reviewers for the article (Pope, page 4, lines 8-13).
- the Web site automatically contacts each potential reviewer on the ranked list and requests that the potential reviewer agree to review the article (Pope, page 5, lines 1-8).
- the potential reviewers connect to the Web site and agree to review the article (Pope, page 5, lines 1-4).
- the Web site notifies an editor that an evaluation form with responses has been received (page 6, lines 4-5).

Madison teaches the steps of:

- the reviewers complete an evaluation form for the article and submit the evaluation form to the Web site (page 2, lines 27-33, Madison discloses that the reviewer is able to enter comments into a evaluation form on the web page).

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- the Web site notifies the author that an evaluation form has been received (page 2, line 34, Madison discloses that the comments by the reviewers are passed along to the author”).
- the author enters responses to the reviewers evaluation form (page 2, lines 36-39, Madison disclose that the author responses to the reviewers). However, Madison does not explicitly discloses that how the author responses to the reviewers evaluation form. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have appreciated that the author responses to the reviewers evaluation form “directly into the evaluation form” to facilitate the peer review process as well as to simplify the communication between the reviewers and the authors, since all the reviewers and authors are able to access to the evaluation form.
- the editor examines the evaluation form and makes a publication decision (page 2, line 27 – page 3, line 5, Madison discloses that the editor examines the evaluation form to decide the result for the article).
- the editor notifies the author and reviewers of the publication decision (page 7, lines 25-36, Mathew discloses that the publication decision is inform to the author via email, and the reviewers can examine the final report of the decision).

Mathews discloses the step of:

- the reviewers who agree access the article through the Web site (page 13, lines 1-5 from the bottom, Mathews discloses that the reviewers use password and username to examine submissions).

Regarding dependent claim 10, which is dependent on claim 9, refer to the rationale relied to reject claim 9, in which “the reviewers connect to the Web site and complete the evaluation form” is addressed.

Regarding dependent claim 11, which is dependent on claim 9, Pope, Madison and Mathews teach the limitation of claim 9 as explained above. Mathews also discloses that each reviewer has access to completed evaluation forms for an article after the reviewer has submitted an evaluation form for that same article (page 13, lines 1-5 from the bottom, Mathews discloses that the reviewers are able to access to the Web site to update the reviews or examine submissions). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Pope, Madison, and Mathews to provide the reviewers a level degree access, since the reviewers are able to access other review forms.

Regarding dependent claim 12, which is dependent on claim 9, Pope, Madison and Mathews teach the limitation of claim 9 as explained above. Madison discloses that the reviewers have the option of revealing their identity or not to the author (page 2, lines 23-26). Madison does not explicitly teach that each reviewer can “set confidential for sections of the reviewer’s completed evaluation form”. However, the ability to “set confidential for sections of the reviewer’s completed form” would have been obvious to one of ordinary skill in the art at the time the invention was made, in view of Madison, because Madison teaches that the reviewers have “option of revealing their identity” or not to the authors, which suggest the ability to set any type of confidential information should be protected in order to evaluate the article to the author, providing integrity of work.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Pope, Mathews and Madison to increase the accuracy of the information presented in the article, protect the reviewers privacy and objectivity, since “setting confidential for sections of the reviewer’s completed form” would have helped the reviewers openly evaluate the article.

Regarding dependent claim 13, which is dependent on claim 9, Pope, Madison, and Mathews teach the limitation of claim 9 as explained above. Pope also discloses that the authors need password to access the Web site (page 7, lines 4-6). Mathews also discloses that the reviewers need a username and password to access the system to update review (page13, lines 1-6, from the bottom). Pope, Madison and Mathews do not explicitly disclose that authors, reviewers, and editors each have a “user account”. However, the use of “user account” would have been obvious to a person of ordinary skill in the art at the time the invention was made, in view of Pope and Mathews, because Pope and Mathews teach the use of username and password for the reviewers, and authors to access to the article. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Pope, Madison and Mathews to protect the integrity of work, since using username and password ensure that only authorized people such as authors, reviewers, editors who are able work on the article.

Regarding dependent claim 14, which is dependent on claim 13, refer to rationale relied to reject claim 13, in which “a single user account can be for an author, reviewer, editor” is addressed.

Regarding dependent claim 15, which is dependent on claim 9, Pope, Madison, and Mathews

teach the limitation of claim 9 as explained above. Pope also discloses that the article submitted by the author is automatically reformatted into a standard format by the Web site (page 3, line 1-27, Pope discloses that the software “mounts an HTML version of the complete article”).

Regarding dependent claim 16, which is dependent on claim 9, Pope, Madison, and Mathews teach the limitation of claim 9 as explained above. Madison also discloses that the “the major criterion for the selection of potential reviewers is their scholarly expertise as demonstrated by their publication record” (Madison, page 2, line 21-22).

However, Madison does not disclose that the selection of potential reviewers “automatically”. Sumner discloses that “sometimes, automated systems are in place for matching reviewers with submission based on keyword analysis” (Sumner, page 2, lines 3-4), which implies the step of parsing the article between the keywords from the content of the article and the reviewer record.

However, Sumner does not disclose where the keywords come from. Pope discloses that the automated submission module creates keywords after the authors submit their articles (Pope, page 3, lines 24-25) and the subject editor sends “prioritized list of potential reviewers”, which imply that the keywords are created from the content of the submitted article.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Sumner and Pope to provide an automatically selection of potential reviewers to review the article based on the keywords which are parsed from the content of submitted article.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Madison, Mathews, Sumner and Pope to provide more accuracy adjustment to the submitted article, since the combination of “matching reviewers with submission based on keyword analysis”, in view of Sumner, and the “create keywords” from the content of submitted article, in view

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of Pope, would have helped to select the best reviewers to evaluate the particular article in Madison's peer review process.

Regarding dependent claim 17, which is dependent on claim 9, Pope, Madison, and Mathews teach the limitation of claim 9 as explained above. Pope discloses that the Web site facilitates the peer review process for more than one publication (page 4, lines 9-19, Pope discloses that using the web for peer review process is able to handle in different categories, and each category has many reviewers).

Regarding dependent claim 18, which is dependent on claim 9, Pope, Madison, and Mathews teach the limitation of claim 9 as explained above. Pope, Madison, and Mathews teach that multiple reviewers complete evaluation forms for each article and multiple editors examine the evaluation forms for each article and the editors communicate with each other via the Web site to arrive at the publication decision for each article is addressed.

Regarding dependent claim 19, which is dependent on claim 9 Pope, Madison, and Mathews teach the limitation of claim 9 as explained above. Pope discloses that the Web site allows the article to iterate through the peer review process until the article is approved for publication (page 1, lines 1-10).

Regarding dependent claim 20, which is dependent on claim 19 Pope, Madison, and

Mathews teach the limitation of claim 19 as explained above. Pope discloses that after an article has been approved for publication a copy editor creates a galley proof of the article, the author and editor approve the galley proof, and the article is immediately published on the Web site (page 7, lines 4-7).

Regarding dependent claim 22, which is dependent on claim 19, Pope, Madison, and Mathews teaches the limitation of claim 19 as explained above. Madison also discloses the publication decision is acceptance of the article pending a revision such that the revision iteratively comprises the steps of:

- the authors editing the article and resubmitting the article to the reviewers (Madison, page 2, lines 34-39).
- the reviewers reevaluating the article and completing an evaluation form (Madison, page 2, lines 34-39).
- the authors responding to each evaluation form (Madison, page 2, line 34-39).
- the editors examining the evaluation form and the author's response and making a publication decision (Madison, page 2, line 27 – page 3, line 5).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Pope, Mathews and Madison to provide the entire peer review process on-line, since the revision when an article have been accepted is also process on the Web.

6. Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maddison et al., "Peer review", copyright 1998, pages 1-3 in view of Pope et al., "Using the web for peer review and publication of scientific journals", September 1998, pages 1-10, Mathews et al., "Electronic Management of the Peer Review Process", May 6-10, 1996, pages 1-21, as applied to claim 1

above, and Sumner et al., “Open Peer Review & Argumentation: Loosening the Paper Chains on Journals”, September 11 1996, pages 1-10.

Regarding dependent claim 2, which is dependent on claim 1, Madison, Pope and Mathews teach the limitation of claim 1 as explained above. Madison also discloses that the “ the major criterion for the selection of potential reviewers is their scholarly expertise as demonstrated by their publication record” (Madison, page 2, line 21-22).

However, Madison, Pope and Mathews do not disclose that the selection of potential reviewers “automatically”. Sumner discloses that “sometimes, automated systems are in place for matching reviewers with submission based on keyword analysis” (Sumner, page 2, lines 3-4), which implies the comparison between the keywords from the content of the article and the reviewer record.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Madison, Pope, Mathews and Sumner to provide an automatically selection of potential reviewers to review the article, since it would have helped the facilitate peer review process of Madison.

However, Sumner does not disclose where the keywords come from. Pope discloses that the automated submission module creates keywords after the authors submit their articles (Pope, page 3, lines 24-25), which implies that the keywords are created from the content of the submitted article.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Madison, Mathews, Sumner and Pope to provide more accuracy adjustment to the submitted article, since the combination of “matching reviewers with submission based on keyword analysis”, in view of Sumner, and the “create keywords” from the content of submitted article, in view of Pope, would have helped to select the best reviewers to evaluate the particular article in Madison’s peer review process.

Allowable Subject Matter

7. Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Paik et al. (U.S. Pat No.6,122,643, 09/19/2000) teaches method and system for electronic article submission.

Ivanov (U.S. Pat No.5,706,452, 01/06/1998) teaches method and apparatus for structuring and managing the participatory evaluation of documents by a plurality of reviewers.

de Vries et al. (U.S. Pat No.5,819,032, 10/06/1998) teaches electronic magazine which is distributed electronically from a publisher to multiple subscribers.

Truong. (U.S. Pat No.6,151,609 , 09/21/2000) teaches remote editor system.

Moody et al. (U.S. Pat No.5,890,177, 03/30/1999) teaches method and apparatus for consolidating edits made by multiple editors working on multiple document copies.

Plantz et al. (U.S. Pat No.6,088,702, 07/11/2000) teaches group publishing system.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu v Huynh whose telephone number is (703) 305-9774. The examiner can normally be reached on Monday through Friday except the second Friday of each biweek.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Herndon R Heather can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.

TVH
July 2, 2001


STEPHEN S. HONG
PRIMARY EXAMINER